

## **REMARKS**

This is a full and timely response to the non-final Office Action mailed on December 22, 2004 (Paper No./Mail Date 12062004). Reconsideration and allowance of the Application and present claims are respectfully requested. Applicants should not be presumed to agree with any statements made by the Examiner regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by Applicants.

### **I. Response to Claim Rejections Under 35 U.S.C. §103**

Claims 1-2 and 4 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,293,762, to *Farkhan* in view of U.S. Patent No. 5,390,825, to *Rockel*. Claim 3 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Farkhan* and in view of U.S. Patent No. 5,962,779, to *Bass*. Claim 1 is amended for clarification purposes to correct antecedent references within the claim only.

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all steps/elements/features of the claimed invention to one of ordinary skill in the art. See, e.g., *In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

#### **A. Claim 1**

Claim 1, as amended, recites:

An apparatus for filling a tire and wheel assembly with a mixture of reactants for reacting within a tire to create a foam-fill within said tire, comprising:

***a cart having a work surface for receiving said tire and wheel assembly;***

a mixer mounted to the cart for receiving said reactants; supply lines attached to the mixer for delivering the reactants to the mixer and creating a mixture of said reactants;

***a gas supply line attached to the mixer for delivering gas to be entrained in the reactants in the mixer; and***

the mixer including an outlet for injecting the mixture of said reactants and entrained gas into said tire and wheel assembly.

(Emphasis Added)

- i. The cited references fail to disclose, teach or suggest “a cart having a work surface for receiving said tire and wheel assembly,” as recited in claim 1

In the Office Action, it was alleged that “the addition of a workspace for the cart is a mere work surface configuration for the apparatus and is nothing exemplary that a regular work-table could not already provide.” (See Office Action, page 3). Applicants respectfully disagree with the allegation.

In fact, “[t]he mere fact that a prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 33 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Applicants respectfully submit that the cited references fail to disclose, teach or suggest the desirability of a cart having a work surface for receiving a tire and wheel assembly, as recited in claim 1. Consequently, a prima facie case of obviousness cannot be established. Accordingly, Applicants respectfully request that claim 1 be allowed and the rejection be withdrawn for at least this reason, among others.

- ii. *Farkhan* fails to disclose, teach or suggest “gas supply line attached to the mixer for delivering gas to be entrained in the reactants in the mixer,” as recited in claim 1

The Office Action alleges that *Farkhan* discloses “a line, which is read on as a hose and anticipates gas supply line (See Fig. 1 element 40) for introduction of materials into a conduit of the sort. The *Farkhan* 762 apparatus has the ability to be modified from an apparatus that introduces a liquid sealant for flat proofing tires to introduce a foamy substance instead.” (See Office Action, page 3). Applicants respectfully disagree with the allegations made in the Office Action. *Farkhan* does not disclose, teach or suggest a gas supply line. *Farkhan*’s element 40 is not a gas supply line. Element 40 is identified as a line for receiving sealing liquid 37 and passing it on to tool 41. Column 3, lines 18-31. If element 40 is modified to be a gas supply line, then there would be no line or lines for introducing the reactants to create the foam fill within the tire.

As mentioned above, “the mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch, supra*. The *Farkhan* reference makes no suggestion of modifying the apparatus from delivering liquid sealant for keeping air from leaking out of a tire to introducing a foamy substance for replacing air in a tire. In fact, the *Farkhan* reference discloses the following:

“The present invention can also be used with other automotive liquids that are not used in tires. Such a fluid could be a lubricant, a motor oil, a light grease, a power steering fluid, a transmission fluid, a differential gear oil, a brake fluid, a windshield washer fluid or other automotive fluid.” (Col. 5, lines 28-33)

Nowhere in the *Farkhan* reference is there provided any suggestion of supplying foamy substance for flat proofing tires. The Office Action acknowledges that *Farkhan* fails to disclose a mixer as recited in the claims. This has significance in that Applicants’ apparatus is for the purpose of providing a mixture of reactants for reacting within a tire to create a foam fill within the tire. The mixer is provided in order to mix the reactants to cause the reaction and create the foam. Additionally, a gas supply line is provided attached to the mixer for delivering gas to be entrained in the reactants in the mixture. This entrained gas also helps create the foam.

Moreover, *Farkhan* is directed to providing a different solution than Applicants, namely keeping air from leaking out of a tire as opposed to replacing air in a tire with foam. The *Farkhan* reference discloses using only a liquid sealant and does not disclose providing a foam fill in a tire. Since *Farkhan* does not teach or suggest using foam to fill a tire, there is no teaching or suggestion to modify *Farkhan* to add a mixer for creating foam or for providing a gas supply line attached to the mixer for delivering gas to be entrained in the reactants in the mixer to assist in creating the foam. *Farkhan* discloses only one line leading to tool 41, namely the liquid supply line 40. *Farkhan* does not teach or suggest supply lines attached to a mixer for delivering reactants to the mixture and additionally, a gas supply line attached to the mixer for delivering gas to be entrained in the reactants in the mixture.

iii. The combination of *Farkhan* in view of *Rockel* fails to establish a *prima facie* case of obviousness

The Office Action alleges that the *Rockel* reference discloses “a portable self contained, two-part adhesive dispensing device which is used for pumping adhesive sealant material. An epoxy and hardener are contained separately prior to being mixed together and injected into a work material (column 3, lines 37-49). The apparatus taught in *Rockel* 825 includes a static mixer (column 7, line 43) that is attached to a hose line inlet (column 7. Lines 37-41) for receiving materials for mixing before ejecting the composite resin from an outlet (column 7, lines 44-45).” (See Office Action, page 3).

Applicants respectfully submit that the *Rockel* 825 reference does not teach, disclose or suggest a cart having a work surface for receiving a tire and wheel assembly and gas supply line attached to the mixer for delivering gas to be entrained in the reactants in the mixer, as recited in claim 1. Thus, Applicants respectfully submit that *Farkhan* in view of *Rockel* fails to disclose, teach, or suggest “a cart having a work surface for receiving said tire and wheel assembly,” as recited in claim 1.

In addition, Applicants respectfully submit that *Farkhan* in view of *Rockel* fails to disclose, teach, or suggest “a gas supply line attached to the mixer for delivering gas to be entrained in said reactants in the mixer,” as recited in claim 1. *Rockel* does not teach or suggest delivering or creating a foam fill within a tire. *Rockel* is directed to a different problem than Applicants’ claimed apparatus. *Rockel* is directed to an apparatus for delivering adhesive, not for creating a foam fill. A gas supply line attached to the mixer for delivering gas to be entrained in the reactants in the mixer would be detrimental to the adhesive of *Rockel*. Thus, there can be no teaching or suggestion in *Rockel* to add such a gas supply line.

Consequently, a *prima facie* case of obviousness cannot be established as even this combination fails to result in all of the elements recited in the claims. Accordingly, Applicants respectfully request that claim 1 be allowed and the objection with drawn for at least this reason, among others.

B. Claims 2-4

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-4 are allowable as a matter of law for at least the reason that dependent claims 2-4 contain all features and elements of their respective independent base claim. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 2-4 should be withdrawn for at least this reason, among others.

C. New Claims 5-7

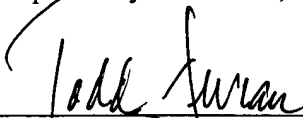
New claims 5-7 have been added. No new material is believed to be included in these new claims. Support for claim 5 can be found in the specification at page 8, lines 21-22. Support for claims 6 and 7 may be found at page 8, lines 3-20.

Applicants submit that none of the cited references teach or suggest the features of any of these new claims. Further, Applicants submit that since the new claims are dependent upon claim 1, they are also allowable for the same reasons stated above in regards to claim 1.

**CONCLUSION**

Applicants respectfully maintain that the currently pending claims 1-4 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Todd Deveau", written over a horizontal line.

**Todd Deveau, Reg. No. 29,526**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500